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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/658,838	09/08/2000	David M. Buczek	05770-138001 / ASC-530	2854

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EXAMINER

NORRIS, JEREMY C

ART UNIT PAPER NUMBER

2827

DATE MAILED: 03/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/658,838

Applicant(s)

BUCZEK ET AL

Examiner

Jeremy C. Norris

Art Unit

2827

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-13, 16-18 and 23-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-13, 16-18 and 23-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 15.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12 August 2002 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-5,7-13,16-18 and 23-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 3,390,357 (hereafter Thomson) in view of US 6,313,408 (hereafter Fujikami).

Thomson discloses, referring to figure 3, a superconducting article (18) sealed by a cured polymer (102) which forms a seal to prevent the intrusion of cryogenic material (76) into the superconductor, wherein the article is in the form of a coaxial cable.

Thomson does not specifically state that the superconductor is a ceramic tape.

However, it is well known in the art to comprise superconductors of ceramic based tapes in cryogenically cooled coaxial cables as evidenced by Fujikami (see figure 5, and the corresponding description). Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to use a ceramic superconductor tape in the invention of Thomson as is well known in the art and evidenced by Fujikami. The motivation for doing so would have been to employ a flexible conductor in the cable, which is resistant to failure by fracture [claims 1]. Moreover, it would have been obvious, to one having ordinary skill in the art, at the time of invention, to form the cable of any length as a change in size is generally recognized as being within the level or ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955) [claim 7].

Furthermore, it would have been obvious, to one having ordinary skill in the art, at the time of invention, to make the polymer layer resistant to any of a range of pressurized fluids as it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233 [claims 10, 11, 24, 25]. In addition, the modified

invention of Thomson discloses that the polymer layer (Kapton, see Fujikami col. 7, lines 40-65) has an elongation of about 0.5% and inherently has a tensile strength of at least 100 MPa at 77K [claims 16-18] and that the ceramic superconducting tapes comprise a plurality of superconducting ceramic filaments and a metal matrix supporting the filaments (see Fujikami, col. 2, lines 40-65) [claim 8]. Finally, is it also clear that the cable of the modified invention of Thomson does indeed disclose a metal substrate (92) supporting the superconductor as a portion of the sealing layer (100, 92, 102) [claims 2-4, 9, 23, 26, 27, 28], where the support is conductive along a direction parallel to the superconducting tapes while maintaining signal integrity by minimizing the capacitance (see Thomson col. 3, lines 50-75) [claims 12, 13]

Response to Arguments

Applicant's arguments with respect to claims 1-5,7-13,16-18 and 23-28 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 6,370,405, granted to Riley, Jr. et al...

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy C. Norris whose telephone number is 703-306-5737. The examiner can normally be reached on Mon.-Th., 9AM - 6:30 PM and alt. Fri. 9AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David L. Talbott can be reached on 703-305-9883. The fax phone numbers

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for the organization where this application or proceeding is assigned are 703-308-0725 for regular communications and 703-308-0725 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

JCSN
January 27, 2003

David A. Zarneke
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AU 2827